

REMARKS

Claims 16-41 are pending in the above application.

The Office Action dated September 21, 2005, has been received and carefully reviewed. In that Office Action, claims 16-38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi. Claims 39-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi and further in view of Mincy. It is not believed that these references show or in any manner suggest the invention required by the pending claims. Reconsideration and allowance of claims 16-41 is respectfully requested in view of the following remark.

A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN PRESENTED

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings ... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142.

All pending claims are rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of references. The specific rejections will be addressed below. However, as an initial matter, it is noted that a motivation for combining the references has not been identified. Instead, the Office Action makes a statement regarding each reference and then states that it would have been obvious to combine the references. Because no motivation for combining the references has been identified, the Office Action fails to present a *prima facie* case of obviousness. See MPEP 2143. Until a *prima facie* case of obviousness is presented, it is respectfully submitted that Applicant is not required to provide evidence of non-obviousness.

SPECIFIC REJECTIONS

Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi. A motivation for combining these references has not been identified, and therefore, a *prima facie* case of obviousness has not been presented. For the reasons provided above, it is respectfully submitted that claim 16 patentably distinguishes over the references of record.

Claims 17-27 depend from claim 16 and are submitted to be allowable for at least the same reasons as claim 16. In addition, claim 26 requires that a still image producing portion cut out and record a still image by detecting a switching of a sound multiplex mode. The Office Action indicates that such a switching is disclosed in Yoshimura at column 5, lines 5-27. These lines of Yoshimura mention "frequency multiplexing" in connection with the modulation of a luminance signal. Neither these lines nor the remainder of Yoshimura show or suggest a sound multiplex mode, much less recording still images by detecting a switching of a sound multiplex mode as claimed. Claim 26 further distinguishes over the art of record for this reason.

Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi. A motivation for combining these references has not been identified, and therefore, a *prima facie* case of obviousness has not been presented. For at least this reason, it is respectfully submitted that claim 28 patentably distinguishes over the references of record.

Claims 29-38 depend from claim 28 and are submitted to be allowable for at least the same reasons as claim 28.

Claim 39 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi and further in view of Mincy. No motivation for combining these references is identified, and therefore, a *prima facie* case of obviousness has not been presented. Claim 39 is submitted to be allowable for at least this reason.

Claim 40 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi and further in view of Mincy. No motivation for combining these references is identified, and therefore, a *prima facie* case of obviousness has not been presented. Claim 40 is submitted to be allowable for at least this reason. In addition, the Office Action indicates that Mincy discloses "a recording and reproducing system wherein a video camera is used to

reproduce and record video content as well as still pictures.” It is respectfully submitted that Mincy discloses a video editing system that in no manner shows or suggests a system for recording still images, at column 2, lines 35+ as stated in the Office Action or anywhere else in the patent. Thus, even if a motivation for combining these references could be identified, the result would not be the invention required by claim 40. Claim 40 is submitted to be allowable for at least this reason.

Claim 41 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of Sakaegi and further in view of Mincy. No motivation for combining these references is identified, and therefore, a *prima facie* case of obviousness has not been presented. Claim 41 is submitted to be allowable for at least this reason. In addition, the Office Action indicates that Mincy discloses “a recording and reproducing system wherein a video camera is used to reproduce and record video content as well as still pictures.” It is respectfully submitted that Mincy discloses a video editing system that in no manner shows or suggests a system for recording still images, at column 2, lines 35+ as stated in the Office Action, or anywhere else in the patent. Thus, even if a motivation for combining these references were identified, the result would not be the invention required by claim 41. Claim 41 is submitted to be allowable for at least this reason.

ONE OF THE CITED REFERENCES IS NOT PRIOR ART

The Office Action concludes with an identification of “prior art made of record and not relied upon.” For the record, Applicant notes that one of these references, Nakatani, U.S. 6,839,502, was filed after the filing date of the present application and is therefore not prior art.

CONCLUSION

Each issue raised in the Office Action dated September 21, 2005, has been addressed, and it is believed that claims 16-41 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750)

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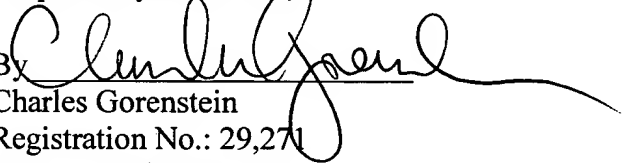
Docket No.: 0033-0685P

at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


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Respectfully submitted,

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